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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : William T. Ball  
SERIAL NO.: 10/732,726  
FILED : December 10, 2003  
TITLE : METHOD AND APPARATUS FOR ASSEMBLING AND SEALING  
BATHTUB OVERFLOW AND WASTE WATER PORTS  
Group/A.U.: 3751  
Conf. No. : 2017  
Examiner : Robert M. Fetsuga  
Docket No.: P06239US1-152

**PETITION TO OVERTURN EXAMINER'S DECISION TO DISAPPROVE  
DRAWING CORRECTION AS CONTAINING NEW MATTER AND  
REQUEST TO ENTER THE DRAWING AMENDMENT**

Mail Stop Petition  
To: Mr. Richard A. Bertsch  
Technology Center Director  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

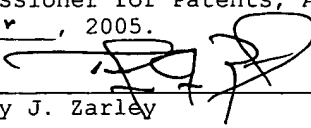
Pursuant to M.P.E.P. 1002.02(c)(4), 37 C.F.R. § 1.113 and 1.181 Applicant petitions the Director of the Technology Center to overturn the Examiner's decision to disapprove and not enter a drawing correction as containing new matter and request the Director enter the drawing amendment.

Submitted herewith is a check for \$130.00 for the petition fee. A duplicate copy of this sheet is enclosed. If there is any deficiency in this fee, please charge Deposit Account 50-2098.

Applicant is a small entity.

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CERTIFICATE OF MAILING (37 C.F.R. § 1.8(a))

I hereby certify that this document and the documents referred to as enclosed therein are being deposited with the United States Postal Service as First Class mail addressed to: Mail Stop Petitions, Commissioner for Patents, Alexandria, VA 22313-1450, on this 27<sup>th</sup> day of December, 2005.

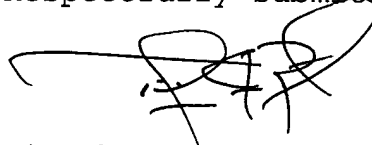
  
Timothy J. Zarley

12/30/2005 MGBREH1 00000022 10732726 130.00 OP  
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**POINT TO BE REVIEWED AND ACTION REQUESTED**

Applicant respectfully requests the Director review Examiner's disapproval of Fig. 8 as new matter and requests the Director to enter Fig. 8 into the record as proper, because the figure does not present new subject matter. Attached hereto is a brief in support of this Petition.

Respectfully submitted,



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- JLH/jlk -



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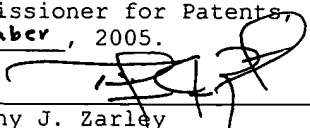
**BRIEF IN SUPPORT OF PETITION TO OVERTURN EXAMINER'S DECISION  
TO DISAPPROVE DRAWING CORRECTION AS CONTAINING NEW MATTER AND  
REQUEST TO ENTER THE DRAWING AMENDMENT**

On October 24, 2005, in a final office action the Examiner did not enter a proposed drawing correction because the Examiner disapproved of the proposed drawing correction as containing new matter. The proposed drawing correction is the addition of a Fig. 8 that takes every step of amended method claim 1 and places it in a box. (Please see attached).

According to M.P.E.P. 608.01(1) "In establishing a disclosure, Applicant may rely not only on the description and drawings as filed but also on the original claims if their

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Timothy J. Zarley

content justifies it." When comparing the subject matter contained in each box of Fig. 8 to the original claims and/or specification, the figure provides no new matter.

In the box designated with the numeral 110 the wording states: "Sealing a thin diaphragm over the overflow port and the waste water port". Original claim 1 states "placing a thin diaphragm over the overflow port and waste water port". The word "placing" in original claim 1 was amended to state "sealing" during the prosecution of this application in an attempt to appease the Examiner regarding a 35 U.S.C. § 112 requirement. Proper support for this amendment is found on page 6, line 15-25 of the original specification that states in part "A thin diaphragm 80 is sealed to the outer end 70 of the end portion". The structure of a thin diaphragm sealed on the end portion of the overflow port is shown in Fig. 4. Additionally support is found on page 7, lines 10-23 that states "The upper end terminates in an annular flange 24A and in one embodiment is covered by a membrane 26A." Additionally original Fig. 6 shows the sealing arrangement of the membrane on the waste water port. The Applicant considers the word "placing" and "sealing" synonymous with each other because by covering or placing a membrane over a port one is effectively sealing the port. Additionally, this amendment was only made in an attempt to appease the Examiner regarding a 35 U.S.C. § 112 issue. Thus the placement of the word "sealing" within box 110 does have proper support in the original claims and the specification.

Boxes 112 and 114 of Fig. 8 provide language that is identical to original claim 1. The Examiner does not appear to object to either of these boxes as presenting new matter and Applicant believes they are proper.

The next part of the proposed Figure that the Examiner has objected to is the information provided in box 116 that states

"opening the diaphragms to thereafter permit the flow of fluid through the overflow port and the waste water port; wherein the diaphragms are opened by physically cutting them open to permit fluid flow." Original claim 1 states: "opening the diaphragms to thereafter permit the flow of fluid through the overflow ports and the waste water port." While original claim 2 states: "wherein the diaphragms are opened by physically cutting it open to permit fluid flow". As a note a grammatical correction was made changing the word "it" in the original claim 2 to "them", however, no other changes were made and the identical wording of what is shown in box 116 is present in the original claims and cannot be considered new subject matter.

The Examiner in disapproving and not entering the proposed drawing correction as containing new matter states "the proposed Fig. 8 would not obviate the outstanding Rule 83(a) drawing objection even if the drawing correction was otherwise acceptable. Merely placing recited ing words in boxes does not define what is involved when performing the claimed acts." Applicant believes that such statement is advisory because before making such an objection the new figure would have to be entered into the record. However, to the effect that if Fig. 8 is entered and the Examiner has objected to the figures not satisfying the requirements of Rule 83(a) the Applicant cannot agree. According to 37 C.F.R. § 1.83:

The drawings in a non-provisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims where the detailed illustration is non-essential for the proper understanding of the invention, should be illustrated in the drawings in the form of a graphical drawing assembly or a labeled representation (e.g. a labeled rectangular box).

The Examiner has objected to the drawings as not showing the sealing, charging, purging, providing, and detachably engaging steps of the claims. The Applicant believes that it is not possible to show action within a still drawing and such an objection in itself is improper, and this objection is the subject matter of another Petition being provided to the Director regarding this final office action. However, in an attempt to appease the Examiner the Applicant submitted new Fig. 8 that placed all of the steps and actions within boxes. Specifically the actions such as sealing, charging, and purging are known actions in the art and are not essential for a proper understanding of the invention.

The invention involves the structure of an overflow and waste water port assemblies and the use of that structure during a conventional testing procedure. Thus the amendment placing all of the method elements within rectangular boxes was an attempt by the Applicant to conform with 37 C.F.R. § 1.83(a) by illustrating these non-essential actions in a labeled representation, e.g. the labeled rectangular box as suggested by 37 C.F.R. § 1.83. The Applicant does not know of any other way of showing actions taking place within still, non-moving figures.

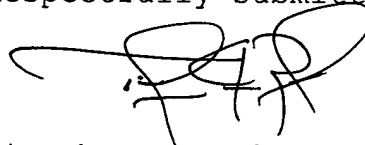
Thus to the effect that the issue is before the Director in this Petition if there is a proper way of showing actions being taken in figures, Applicant asserts that Fig. 8 is the best representation in the spirit of 37 C.F.R. § 1.83(a) of showing this action. Thus if the issue is present the Applicant would respectfully request that the Director not only enter Fig. 8 into the record but also find that Fig. 8 in itself overcomes the drawing objection that the Examiner has alleged.

Therefore because the original claims must be considered when determining what is and is not new matter and because the

change of the word placing to sealing had proper support in the original specification and claims, Applicant submits that no new matter is present within the newly proposed Fig. 8.

Consequently, Applicant respectfully requests that the Examiner's decision to disapprove and not enter Fig. 8 be overturned and requests that Fig. 8 be entered into the record of the application. Additionally to the effect that the Examiner's statement in his objection that this proposed amendment would not overcome the present drawing objections, the Applicant respectfully requests this decision also be overturned.

Respectfully submitted,



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